

THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE TTAB

Mailed:
24 May 06

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Associated Couriers, Inc.

Serial No. 76543954

Annette P. Heller, Esq. for Associated Couriers, Inc.

Giselle M. Agosto, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Bucher, Drost, and Cataldo, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 28, 2003, applicant Associated Couriers,
Inc. applied to register the mark ASSOCIATED COURIERS, INC.
in the stylization shown below for "courier services,
namely the pickup, delivery and storage of medical supplies
for use in nuclear medicine" in Class 39.

Associated
COURIERS, INC.

Ser No. 76543954

The application contains an allegation of a date of first use anywhere and a date of first use in commerce of March 1977 and a disclaimer of the term "Couriers, Inc."¹

The examining attorney² has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of twelve registrations owned by the same entity, Associated Global Systems, Inc., for the following marks.

I.

Reg. No. 2,132,367

Issued: January 27, 1998

ASSOCIATED/COURIER/EXPRESS

for: air and truck transportation and the storage of goods

Class: 39

Dates of first use: September 12, 1983 (both)


Disclaimer: Courier Express

Status: Section 8 and 15 affidavits accepted or acknowledged

II.

Reg. No. 1,722,538

Issued: October 6, 1992

ASSOCIATED 
DISTRIBUTION
  **LOGISTICS**

¹ Serial No. 76543954.

² The current examining attorney was not the original examining attorney in this application.

Ser No. 76543954

for: air and surface transportation and storage of goods
Class: 39
Dates of first use: June 1989 (both)
Disclaimer: Logistics
Status: Renewed

III.

Reg. No. 2,128,521
Issued: January 13, 1998



for: air and truck transportation and the storage of goods
Class: 39
Dates of first use: December 1, 1995 (both)
Disclaimer: Systems
Status: Section 8 and 15 affidavits accepted or
acknowledged

IV.

Reg. No. 2,127,265
Issued: January 6, 1998
Dates of first use: March 15 1982 (both)
Mark: ASSOCIATED INBOUND (typed)
for: air and truck transportation and the storage of goods
Class: 39
Disclaimer: Inbound
Status: Section 8 and 15 affidavits accepted or
acknowledged

V.

Reg. No. 2,128,871
Issued: January 13, 1998

ASSOCIATED AIR FREIGHT INC.

for: air and truck transportation and the storage of goods
Class: 39
Dates of first use: October 1, 1958 (both)
Disclaimer: Air Freight Inc.
Status: Section 8 and 15 affidavits accepted or
acknowledged

VI.
Reg. No. 2,128,872
Issued: January 13, 1998

ASSOCIATED //////SAME DAY

for: air and truck transportation and the storage of goods
Class: 39
Dates of first use: August 1, 1983 (both)
Disclaimer: Same Day
Status: Section 8 and 15 affidavits accepted or
acknowledged

VII.
Reg. No. 2,128,880
Issued: January 13, 1998

ASSOCIATED //////AIR FREIGHT

for: air and truck transportation and the storage of goods
Class: 39
Dates of first use: October 1, 1958 (both)
Disclaimer: Air Freight
Status: Section 8 and 15 affidavits accepted or
acknowledged

Ser No. 76543954

VIII.

Reg. No. 2,127,269

Issued: January 6, 1998



for: air and truck transportation and the storage of goods

Class: 39

Dates of first use: September 12, 1978 (both)

Disclaimer: Priority Overseas

Status: Section 8 and 15 affidavits accepted or
acknowledged

IX.

Reg. No. 2,127,273

Issued: January 6, 1998

Mark: ASSOCIATED SECOND DAY (typed)

for: air and truck transportation and the storage of goods

Class: 39

Dates of first use: August 1, 1983 (both)

Disclaimer: Second Day

Status: Section 8 and 15 affidavits accepted or
acknowledged

X.

Reg. No. 2,127,274

Issued: January 6, 1998

Mark: ASSOCIATED OVERNIGHT (typed)

for: air and truck transportation and the storage of goods

Class: 39

Dates of first use: August 1, 1983 (both)

Disclaimer: Overnight

Status: Section 8 and 15 affidavits accepted or
acknowledged

XI.

Reg. No. 2,171,163

Issued: July 7, 1998



for: air and truck transportation and the storage of goods
Class: 39
Dates of first use: March 30, 1987 (both)
Disclaimer: Parts Stock³
Status: Section 8 and 15 affidavits accepted or
acknowledged

XII.
Reg. No. 2,172,683
Issued: July 14, 1998



for: air and truck transportation and the storage of goods
Class: 39
Dates of first use: November 1, 1993 (both)
Disclaimer: International
Status: Section 8 and 15 affidavits accepted or
acknowledged

The examining attorney's position is that:

"Applicant's mark and registrant's marks comprise the word ASSOCIATED followed by disclaimed terms that are descriptive or generic for the respective services. As such, the marks are nearly identical." Examining Attorney's Brief at unnumbered p. 3. Furthermore, the

³ We note that the word in the mark is "Partstock" and the disclaimer is for the words "Parts Stock."

examining attorney (Brief at unnumbered p. 10) argues that the "identification of registrant's services is very broad, [and] it is presumed that the registration encompasses all goods and/or services of the type described, including those in the applicant's more specific identification." Specifically, the examining attorney concludes that we "must proceed under the assumption that registrant's transportation and storage of goods services [do] indeed include medical supplies for use in nuclear medicine." Examining Attorney's Brief at unnumbered p. 11.

Applicant argues that although it "agrees that ASSOCIATED has not been frequently adopted or diluted in the courier industry, it is of no relevance because the question is not whether ASSOCIATED has already been diluted, but rather whether ASSOCIATED is capable of being diluted due to its highly suggestive connotations." Reply Brief at 2. Applicant also argues that "shipping of nuclear medicine requires a courier to obtain a special license" and that purchasers of these services would "perform some careful research." Reply Brief at 5. Finally, applicant maintains that there has been no actual confusion between the marks of applicant and registrant despite the fact that applicant has been ranked 48th among

carriers and the parties have co-existed for nearly three decades. Reply Brief at 7.

Before we begin our analysis of the likelihood of confusion issue, we first must address an evidentiary question. In its brief (p. 9), applicant asserts that its "conclusion is buttressed by the fact that there are approximately 100 registered marks incorporating the term ASSOCIATED that, in fact, co-exist and are used in association with many types of goods and services." The examining attorney objects to applicant's attempt to introduce new evidence on appeal. The examining attorney also notes that the term "Associated" is "neither descriptive of the identified services in the application or in the registrations, nor is it 'diluted' in the sense that there are other ASSOCIATED marks in use for related services. To the contrary, the only ASSOCIATED marks in the relevant field that were identified by the examining attorney were registrant's family of twelve ASSOCIATED marks." Examining Attorney's Brief at unnumbered p. 5. In its reply brief (p. 2), applicant agrees that "Associated has not been frequently adopted or diluted in the courier industry."

Regarding the examining attorney's objection to applicant's attempt to introduce new evidence on appeal, applicant responds (Reply Brief at 4) as follows:

Although Trademark Examining Attorney may be technically correct in her statement of TTAB procedure, to exclude the evidence in this case would be somewhat unreasonable considering that Applicant, Trademark Examining Attorney, and the Board all have equally easy access to the electronic search records of the USPTO. In addition, Applicant did not want to burden the record with over 100 pieces of paper listing each registration containing the term ASSOCIATED since the purpose of Applicant's reference was to simply give Trademark Examining Attorney and the Board notice of these registrations rather than to make any specific comparison between Applicant's mark and the marks in the registrations.

We sustain the examining attorney's objection. As the USPTO's rules indicate, the record on appeal should be complete prior to appeal. 37 CFR § 2.142(d). To make third-party registrations of record, applicant or the examining attorney must submit a copy of the registration or a printout from the USPTO's electronic database prior to the briefing stage of the case. In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record"). See also In re First Draft Inc., 76 USPQ2d 1183, 1192 (TTAB 2005) ("Submission of the TARR printout with its appeal brief, however, is an untimely submission of this evidence"). Furthermore, the "Board does not take judicial

notice of third-party registrations." In re Carolina Apparel, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998). In its brief in this case, applicant has simply referred generally to other registrations that are registered in the USPTO. As the cases above indicate, this does not make them of record nor has applicant explained why it did not provide this information sooner. Therefore, we will not consider these references in its brief as evidence. We add that the examining attorney has asserted that these third-party registrations are for unrelated goods or services and applicant has not disputed this point.

We now turn to the question of likelihood of confusion. When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences

in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin in this case by looking at the similarities and dissimilarities of applicant's and registrant's marks. Applicant seeks to register the mark:

ASSOCIATED COURIERS, INC. (stylized)

The examining attorney has cited the following marks as a bar to the registration of applicant's mark:

ASSOCIATED COURIER EXPRESS (and design)
ASSOCIATED DISTRIBUTION LOGISTICS (and design)
ASSOCIATED GLOBAL SYSTEMS (and design)
ASSOCIATED INBOUND
ASSOCIATED AIR FREIGHT INC. (and design)
ASSOCIATED SAME DAY (and design)
ASSOCIATED AIR FREIGHT (and design)
ASSOCIATED PRIORITY OVERSEAS (and design)
ASSOCIATED SECOND DAY
ASSOCIATED OVERNIGHT
ASSOCIATED PARTSTOCK (and design)
ASSOCIATED INTERNATIONAL (and design)

All the cited registrations and applicant's mark begin with the same word "Associated." Applicant and one of the cited registrations (No. 2,132,367) have the word "Courier(s)" as the next word. While applicant uses the plural form of the word "courier" and registrant uses the singular, this minor difference is not significant. Wilson v. Delauney, 245, 877, 114 USPQ 339, 341 (CCPA 1957) ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of

the word "Zombie" and they will therefore be regarded here as the same mark"). Another registration (No. 2,128,871) also ends with the same abbreviation ("Inc.") as applicant's mark. Most of the wording in the registrations other than the word "Associated" has been disclaimed.

We concentrate on registrant's ASSOCIATED COURIER EXPRESS mark. Applicant's mark, ASSOCIATED COURIERS, INC., is very similar to the mark ASSOCIATED COURIER EXPRESS. The marks would be pronounced identically except for the third word, the disclaimed terms INC. and EXPRESS, inasmuch as "Inc." simply designates applicant's legal status and "Express" describes "a rapid method of delivery." U.S. Express Inc. v. U.S. Express Inc., 799 F. Supp. 1241, 25 USPQ2d 1061, 1063 (D.D.C. 1992) (The term "U.S. Express" held to be descriptive). It would be unlikely that these additional terms at the end of the marks would be used by potential purchasers to distinguish the marks. In addition, while applicant argues (Brief at 3) that "registrant's marks are weak and deserving of only a narrow scope of protection," as noted earlier, there is nothing in the record to support this argument. Indeed, applicant agrees that "Associated has not been frequently adopted or diluted in the courier industry." Whether the term "Associated" is weak for other goods and services,

something that has not been shown, is not relevant to whether the term is weak for registrant's services. While we can agree that the term "Associated" is not arbitrary or fanciful, we simply cannot conclude that it is weak and entitled to only a narrow scope of protection.

Regarding the stylization or design elements of the marks, "design elements such as those appearing in applicant's mark are generally less important than the word portion of the mark in creating an impression." In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001). In addition, we observe that the stylization of the letters in the two marks is actually very similar for the last two words in the marks and the differences in stylization for the word "Associated" is minimal.

Associated
COURIERS, INC.

ASSOCIATED/COURIER/EXPRESS

When viewed in their entireties, the similarities in sound, appearance, meaning, and commercial impression between applicant's and registrant's marks far outweigh the differences created by the different ending terms and the slight differences in stylization. To the extent that

customers notice the difference in the final term, it is unlikely to lead to a conclusion that the terms refer to different entities if the services are related. They are simply likely to assume that it describes an attribute of the courier services, i.e., that it offers "express" delivery. Potential customers are simply likely to assume that ASSOCIATED COURIERS, INC. is the name of the express delivery services that are known as ASSOCIATED COURIER EXPRESS.

Reinforcing our conclusion that the marks ASSOCIATED COURIERS, INC. and ASSOCIATED COURIER EXPRESS are similar is the fact that registrant also owns registrations for the marks ASSOCIATED DISTRIBUTION LOGISTICS, ASSOCIATED GLOBAL SYSTEMS, ASSOCIATED INBOUND, ASSOCIATED AIR FREIGHT INC., ASSOCIATED SAME DAY, ASSOCIATED AIR FREIGHT, ASSOCIATED PRIORITY OVERSEAS, ASSOCIATED SECOND DAY, ASSOCIATED OVERNIGHT, ASSOCIATED PARTSTOCK, and ASSOCIATED INTERNATIONAL for similar services. The registrations all include the term "Associated" and registrant also owns registrations for the term "Courier" and "Inc." Most of the words in the registrations are descriptive words for delivery services, e.g., air freight, second day, overnight, etc. Customers would have virtually no basis to distinguish applicant's mark from the registrant's marks.

Therefore, we conclude that the marks in this case are very similar.

Second, we address the question of whether the services of applicant and registrant are related. Applicant's services are "courier services, namely the pickup, delivery and storage of medical supplies for use in nuclear medicine." Registrant's services are "air and truck transportation and the storage of goods." One registration substitutes the word "surface" for "truck." No. 1,722,538 ("air and surface transportation and storage of goods"). Pickup, delivery, and storage of medical supplies for use in nuclear medicine services are a subset of registrant's air and truck (or surface) transportation and storage of goods services. Indeed, "Applicant admits that there is the possibility that Registrant transports and stores nuclear medicine supplies as a small part of its shipping, storage, and delivery operations." Reply Brief at 5. In fact, regardless of whether registrant is actually shipping and storing nuclear medicine supplies, we must assume for our analysis that these services are included within its identification of services. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the

basis of the respective descriptions of goods [or services]"). Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). We conclude that the services are in part identical inasmuch both applicant and registrant are presumed to be involved with the pickup, storage, and delivery of medical supplies for use in nuclear medicine.

Even if the services were not overlapping, we would have to conclude that they are highly related to the extent that a source of medical supplies or a medical institution that uses a general delivery and storage service is likely to believe that courier and storage services involving nuclear medicine supplies would be related to services involving the delivery and storage of non-nuclear medical supplies to the extent that they are marketed with very similar trademarks. We add that even if the purchasers of these services are careful and sophisticated purchasers, "even careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). For example, a sophisticated

purchaser at a medical supplier that uses registrant's delivery services for some supplies would likely assume that applicant's courier services for nuclear medical supplies originate from related or associated sources.

Applicant also argues (Reply Brief at 7) that its "mark has coexisted with some of Registrant's marks for nearly three decades without a single known instance of actual confusion. As Applicant mentioned in its Appeal Brief, this is quite extraordinary considering that Applicant has been ranked #48 in the Top Carriers listed by operating ratio."⁴

Recently, the Federal Circuit has addressed the question of the lack of evidence of actual confusion, particularly in an ex parte context:

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See In re Bissett-Berman Corp., 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, J.C. Hall Co. v. Hallmark Cards, Inc., 52 C.C.P.A. 981, 340 F.2d

⁴ The list actually says "The *Other* Top 100 Couriers." (Emphasis added).

960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an ex parte context.

Majestic Distilling Co., 65 USPQ2d 1201, 1205. The absence of actual confusion does not mean there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991).

Here, the only evidence of a lack of actual confusion consists of the application, the arguments of applicant's attorney that applicant has used the mark for more than three decades and that there has not been any actual confusion, and a single page from the *Commercial Carrier Journal*, August 2004. The page is entitled "The Other Top 100 Carriers listed by operating ratio." In that list, "Associated Couriers, Maryland Heights, Mo." is listed 48th. Applicant relies heavily on the case of In re General Motors Corp., 23 USPQ2d 1465 (TTAB 1992). In that case, the applicant provided evidence not only that it used its mark for almost thirty years, but also that it sold 2,695,434 automobiles under the mark GRAND PRIX during that time. This evidence showed that the yearly sales of vehicles under the mark during that period ranged from a low of 16,542 to a high of 288,430 vehicles. In addition,

the applicant included sample advertising and representative stories that demonstrated that the mark had "achieved a degree of renown." Id. at 1470. Furthermore, the applicant presented affidavits from two employees that explained that there have been no complaints of confusion from either the registrant or the public.

Even a cursory comparison of the facts of this application with the General Motors case demonstrates the inadequacy of applicant's evidence. First, the goods in the General Motors case were not identical (automobiles and tires) as opposed to the overlapping services in this case. More importantly, there is no indication of applicant's sales or market penetration besides the list that for a single year, 2003, applicant is identified as #48 in the "Other Top 100 Couriers" list. Besides this list, there is no evidence of renown or advertising on applicant's part. In the General Motors case, it was fair to assume that the registrant had significant opportunities to understand that General Motors was using the mark GRAND PRIX on its vehicles for a long period of time on a national scale. Based on applicant's single piece of evidence, it would be sheer speculation on our part to conclude that registrant is even aware of applicant much less that there has been a significant opportunity for actual confusion to occur.

Based on the record in this case, we cannot conclude that the lack of evidence of actual confusion in this case is sufficient.

Therefore, when we considered that the marks are very similar and the services overlap as well as the other factors, we conclude that confusion is likely.

Decision: The examining attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the cited registered marks used in connection with the identified services under Section 2(d) of the Trademark Act is affirmed.